

REMARKS/ARGUMENTS

Claims 1-6 have been amended. These amendments have been made solely in an effort to advance prosecution. Claims 1-30 are pending, although claims 7-30 are pending and withdrawn.

Applicant's representative reminds the examiner that a thorough search of the application should be performed before indicating, even orally, that subject matter would be allowable. This is particularly true where the examiner has not provided written rejections and expects the claims to be amended before allowance.

Applicant requests that the provisional double-patenting be held in abeyance until receipt of an indication of allowable subject matter in the present application.

Applicant has amended claims 1-6 in an effort to advance prosecution and overcome the indefiniteness rejections. Withdrawal of these rejections is requested.

Claims 1-6 were rejected as allegedly anticipated by Johnston et al., Phospholipid Polymers - Synthesis & Spectral Characteristics, *Biochimica et Biophysica Acta*, 602:57-69 (1980) (Johnston). Johnston, however, does not teach or suggest all claim elements.

As an initial matter, Johnston does not appear to enable the presently claimed subject matter. Specifically, Johnston does not provide enough information to a person of ordinary skill in the art to make the as-claimed living cells. Instead Johnston expressly and intentionally omits the necessary details, reserving them for publication "elsewhere." (Johnston at 68 ("This indicates that a similar polymerisation process occurs within the biomembranes of these cells (this work will be published in detail elsewhere).")

(emphasis added).) Without these details omitted in the cited reference and allegedly published “elsewhere,” Johnston cannot be an enabling reference. *See, e.g., Impax Laboratories Inc. v. Aventis Pharmaceuticals Inc.*, 468 F. 3d 1366, 1381-82 (Fed. Cir. 2006). As explained in MPEP § 2121.01, “[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.” It is plain that Johnston provides no details in its publication beyond mere naming, because Johnston reserves the unstated details for later publication.

Furthermore, the scant disclosure in Johnston does not teach many of the aspects of the pending claims. First, the amended claims require living cells. It is unclear whether the Johnston cells are alive, or whether their treatment (irradiation) destroyed the cells.

Second, Johnston does not teach or even mention “perturbation-sensitive” constructs. The only claim made in that paper is that the monomers somehow (again, without any details given) were incorporated into a cell membrane through the growth media, be polymerized, and then changed color through temperature effects.

Third, Applicant submits that Johnston’s description (as in the previous paragraph) does not make sense at all, because there is no way that the monomers will simply go to the cell membrane, pick up diacetylene fatty acids from the growth medium and be subsequently polymerized. Applicant believes that the diacetylene must be organized on the membrane in order for this to happen, and this is not taught or suggested by Johnston.

Fourth, it also appears that Johnston did not mention at all “nanopatch” organization. Reading Johnston, a person of ordinary skill in the art would understand that the entire cell membrane is covered (or comprises of) the chromatic molecules. This molecular-scale coverage is quite different from nanopatches, as claimed.

And fifth, the presently pending subject matter in an aspect requires PDA-labeled cells to analyze perturbation-sensitive molecules. In contrast, the color changes in Johnston are just induced by temperature (e.g., Johnston at 63-65), which is a different process. This distinction – i.e., perturbation as opposed to temperature – is notable. In an aspect, the lipid/PDA patches in the present case are not just fused/attached to the cell membrane, but essentially sense when membrane processes occur, such as membrane-active molecules insert into the cell membrane etc.

Applicant requests withdrawal of the anticipation rejection over Johnston, at least for the above-stated reasons.

If any small matters remain outstanding (e.g., matters that can be resolved via an Examiner’s Amendment), the Examiner is encouraged to telephone Applicants’ representative. Prompt reconsideration and allowance of this application is requested.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

JELINEK
Appl. No. 10/573,814
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Respectfully submitted,

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